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Docket No. 72242-AB/JPW/GJG

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Allan Green et al.
Serial No.: 09/981,124 Examiner: E. McElwain
Filed : October 17, 2001 Group Art Unit: 1638
For : FATTY ACID EPOXYGENASE GENES FROM PLANTS AND USES
THEREFOR IN MODIFYING FATTY ACID METABOLISM

1185 Avenue of the Americas
New York, New York 10036
October 15, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

RESPONSE TO SEPTEMBER 16, 2004 COMMUNICATION

This is a Response to the September 16, 2004 Communication issued by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the September 16, 2004 Communication is due within one (1) month from the mailing date, i.e. by October 16, 2004. However, because October 16, 2004 is a Saturday, the next succeeding day which is not a Saturday, Sunday or Federal holiday, i.e. Monday, October 18, 2004, is considered timely under 37 C.F.R. § 1.7 and this Amendment is being timely filed.

The September 16, 2004 Communication alleged that applicants' Amendment dated June 17, 2004 is not fully responsive to the February 17, 2004 restriction requirement because applicants have cancelled all original claims and submitted new claims for examination. The Examiner alleged that applicants have not elected one of the groups set forth in the February 17, 2004 restriction requirement. The Examiner then alleged that the new claims submitted by applicants are, "non-elected by original presentation in that they don't correspond to any of the groups

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set forth in the restriction requirement."

In response, applicants initially point out that nothing in the rules of practice before the U.S. Patent and Trademark Office precludes applicants from redrafting their original claims before a first action on the merits to more precisely define their invention. A restriction requirement is not an action on the merits. See, e.g. M.P.E.P. §810.

Indeed, contrary to the September 16, 2004 Communication, M.P.E.P. §818.02, entitled, "Election Other Than Express," provides that, "[e]lection may be made in other ways than expressly in reply to a requirement." Applicants have elected their new claims by filing them in response to the February 17, 2004 restriction requirement. Clearly the Examiner is aware which claims applicants wish to have examined. Thus the June 17, 2004 reply is complete.

More specifically, M.P.E.P. §818.02(a) provides that, "[w]here claims to another invention are properly added and entered in the application before an action [on the merits]¹ is given, they are treated as original claims for purposes of restriction only." (Emphasis added). M.P.E.P. §818.02(a) proceeds to note that only, "claims originally presented [for purposes of restriction] and acted upon by the Office on their merits determine the invention elected by an applicant in the application." Therefore, applicants respectfully request that the claims filed

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The term "action" is consistently used to refer to action on the merits, while the terms "restriction" and "requirement" are used to refer to a restriction requirement in the sections of the M.P.E.P. discussing restriction. See, in particular, M.P.E.P. §810.03 (using the analogous phrase "action is ordinarily given") and M.P.E.P. §815 (using "requirement").

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June 17, 2004 be examined on their merits in compliance with the examination guidelines.

Applicants further note that a search has not been performed in the subject application. Accordingly, the burden on the Examiner is in no way different than if applicants had elected any of the restricted groups of the previous claims.

Finally, applicants point out that claims drawn to transgenic plants were pending before the issuance of the February 17, 2004 restriction requirement. Applicants' new claims to transgenic plants filed June 17, 2004 may be viewed as merely better defining applicants' invention which was pending before the Examiner prior to the issuance of the February 17, 2004 restriction requirement. Thus, while applicants contend that claims to a completely different invention can be presented after a restriction requirement but before an action on the merits as discussed above, applicants' new claims merely clarify an invention that was already being pursued before issuance of the February 17, 2004 restriction requirement.²

Accordingly, applicants respectfully request that the Examiner withdraw the September 16, 2004 Communication and proceed with the examination of new claims 26-49.

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Applicants note that transgenic plant claims were included in all of the groups in the February 17, 2004 restriction requirement. This indicates that, in fact, the February 17, 2004 requirement was actually for a species election, not a restriction, because generic claims were pending which would ultimately have to be examined if an elected species was found allowable. A similar species election, however, does not apply to new claims 26-49 because no specific SEQ ID's are being claimed. M.P.E.P. §809.02(d).

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No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

Gary J. Gershik

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
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